

## **REMARKS**

The Applicants wish to thank the Examiner for his time during the two telephone interviews, which have been entered into record. However, the Applicants do not concur with the first line of the second paragraph of the summary of the telephone interview of June 13, 2007, in a paper dated June 20, 2007; "Agreement is reached in that the specification must teach how to make and use the claimed invention." It has been the unwavering position of the Applicants that the specification of the instant application meets all the requirements of 35 USC § 112, paragraphs 1 and 2, for claimed embodiments of the instant application relating to a method for manufacturing a substrate for a hybridization array by providing a moat around the hybridization array (see, for example, but not limited by FIG. 1C, and FIGS. 2A-2C). Such position has been asserted in, for example, but not limited by, the Declaration under 37 CFR 1.132 by one of the inventors, Mr. Julio P. Focaracci. As such, the entirety of comments made in the summary of the telephone interview of June 13, 2007 should be attributed to the perspective of the Examiner, and not the Applicants.

With respect to corrections made to the drawings, the designation of element 43; a moat, can be found, for example, but not limited by, in paragraphs 37-38, and in paragraphs 40-41. No new matter is indicated by these corrections.

In view of the Final Office Action, as well as the telephone interviews conducted on June 11, 2007 and June 13, 2007, the Applicants have amended Claims 1, 4, 24, 30, and 31 to address issues raised by the Examiner. The Applicants, in careful review of the Action, and comments of record, refer to the MPEP § 2144.03, which states that, with respect to the substantial evidence standard under the Administrative Procedure Act (APA):

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21. See also *In re Grose*, 592 F.2d 1161, 1167-68, 201 USPQ 57, 63 (CCPA 1979)

Further, it is stated in 37 CFR § 104(d)(2):

When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the references must be supported, when called for by the applicant, by the affidavit of such employee,

and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.

The Applicants respectfully submit that they have made reasonable effort to address the assertions made in the rejections made by the Examiner from the Examiner's personal knowledge. For example, in the Office Action dated October 13, 2006, reference was made to *Enzo Biochem Inc., v. Calgene Inc.*, in which eight factors related to enablement were set forth in the opinion. Following the listing of the factors, the Examiner entered into record, for example:

The quantity of experimentation necessary to practice the full scope of the invention is great, on the order of several man-years with little if any reasonable expectation of success.

There were no references cited or reasoning given. A Declaration under 37 CFR 1.132 was made by one of the inventors, Mr. Julio P. Focaracci, and entered in the Response made February 13, 2007. In the Declaration, Mr. Focaracci made every effort in specific detail to address the Examiner's rejections made from the Examiner's personal knowledge. In the Action, the remarks made under Declaration by Mr. Focaracci were dismissed by the Examiner, for example, as, "...It is noted with particularity that the remarks offered are conclusory in nature and void of any factual underpinning."


The Applicants have amended the claims to address concerns made by the Examiner, for example in paragraph 9 of the Action. The Applicants respectfully submit that they have made reasonable attempts to place the application in position for allowance. The Applicants request that, given the substantial evidence standard set in the rules and regulations, should the Examiner continue to assert rejections based on personal knowledge, that the appropriate affidavit should be entered into record, as set forth in 37 CFR § 104(d)(2).

### CONCLUSION

The Applicants submit that all of the claims are in condition for allowance. If the Examiner finds that a telephone conference would expedite the prosecution of this case, the Examiner is invited to contact me at the telephone number listed below.

Respectfully submitted,

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